

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS : Stuart B. Levy, *et al.* CONFIRMATION No.: 8952
SERIAL NUMBER : 10/692,764 EXAMINER : Janet L. Epps-Smith
FILING DATE : October 24, 2003 ART UNIT : 1633
FOR : METHODS OF USING SUBSTITUTED TETRACYCLINE COMPOUNDS
TO MODULATE RNA

Via EFS

APPLICATION FOR ADJUSTMENT OF PATENT TERM UNDER 37 C.F.R. § 1.705(b)

Applicants request reconsideration of the patent term adjustment under 37 C.F.R. § 1.705(b) to 821 days as of the mailing of the Notice of Allowance. In support of this request, Applicants submit the following statement of facts pursuant to 37 C.F.R. § 1.705(b).

(i) The United States Patent and Trademark Office ("Office") calculated the adjustment under 35 U.S.C. § 154(b)(1)(A) as 1050 days (USPTO A Delay). Applicants do not dispute this number.

(ii) The Office calculated the adjustment under 35 U.S.C. § 154(b)(1)(C) as 0 days (USPTO C Delay). Applicants do not dispute this number.

(iii) The correct reduction of patent term under 35 U.S.C. § 154(b)(2)(C), for Applicants' failure to engage in reasonable efforts to conclude prosecution of the application, is 229 days (93 + 92 + 33 + 11). This number differs from that calculated by the Office by 183 days.

Applicants believe that the Office incorrectly attributed 183 days of delay to Applicants under 37 C.F.R. § 1.704. Specifically, Applicants' Supplemental Information Disclosure Statements filed September 10, 2010 and September 14, 2011 both included a statement under 37 C.F.R. § 1.704(d). Applicants hereby reiterate that each item of information contained in the September 10, 2010 Information Disclosure Statement was first cited in any communication from a foreign patent office in a counterpart application and the communication was not received by

any individual designated in 37 C.F.R. §1.56(c) more than thirty days prior to the filing of the IDS. Moreover, Applicants also hereby reiterate that each item of information contained in the September 14, 2011 Information Disclosure Statement was first cited in any communication from a foreign patent office in a counterpart application and the communication was not received by any individual designated in 37 C.F.R. §1.56(c) more than thirty days prior to the filing of the IDS. Accordingly, no delay should have been attributed to the Applicants for the filing of either the September 10, 2010 Information Disclosure Statement or the September 14, 2011 Information Disclosure Statement.

In summary, Applicants respectfully request an adjustment of patent term to indicate a total PTA (as of the mailing date of the Notice of Allowance) of 821 days, which is the sum of periods under 35 U.S.C. § 154(b)(1)(A) (1050 days) and 35 U.S.C. § 154(b)(1)(C) (0 days), less the sum of the periods under 35 U.S.C § 154(b)(2)(C) (229 days), or a total of 821 days.

The above-identified application is subject to a terminal disclaimer to U.S. Patent No. 7,935,687. Prior to the December 8, 2011 mailing date of the Notice of Allowance, Applicants submit that there were no circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination of the application as set forth in 37 C.F.R. § 1.704, other than the circumstances described above.

Applicants reserve the right to request reconsideration of the patent term calculated under 35 U.S.C § 154(b)(1)(B).

Pursuant to 37 C.F.R. § 1.705(b) and § 1.18(e), the fee required for filing this application for patent term adjustment is believed to be **\$200.00**. No additional fees are believed due. Please charge any additional fees due, or credit any overpayment of same, to Deposit Account No. 50-0311, Customer No. 30623, Reference No. 16534-539001US.

Respectfully submitted,

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